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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.														
10/666,386	09/18/2003	Michael C. Withiam	03-203	7517														
7590 Carlos Nieves, Esq. J. M. Huber Corporation 333 Thornall Street Edison, NJ 08837-2220		06/14/2007	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">OH, SIMON J</td></tr><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1618</td><td></td></tr><tr><td colspan="2"><table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>06/14/2007</td><td>PAPER</td></tr></table></td></tr></table>		EXAMINER		OH, SIMON J		ART UNIT	PAPER NUMBER	1618		<table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>06/14/2007</td><td>PAPER</td></tr></table>		MAIL DATE	DELIVERY MODE	06/14/2007	PAPER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/666,386

Applicant(s)

WITHIAM ET AL.

Examiner

Simon J. Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Papers Received***

Receipt is acknowledged of the applicant's response, petition for extension of time and request for continued examination, all received on 20 February 2007.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 December 2006 has been entered.

### ***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claim 10 under 35 U.S.C. 112, second paragraph, as being indefinite is hereby withdrawn in view of the amendment to that claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5, 6, 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by

Withiam *et al.* (U.S. Patent No. 7,163,669, hereinafter Withiam I)

The applied reference has a common inventor and assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

The Withiam I patent teaches fluid cosmetic compositions comprising a calcium silicate (See Abstract). The calcium silicates preferably have an oil absorption of at least 200 mL/100g, with a particle size of less than 20 microns (See Column 3, Line 66 to Column 4, Line 5). The compositions may be in the form of creams, lotions, gels, or a solid stick (See Column 8, Line 62 to Column 9, Line 3). The disclosed compositions include a vehicle comprising various components such as astringents, emollients, emulsifiers, solvents, surfactants, waxes, wetting agents, and water (See Column 6, Line 8 to Column 8, Line 61). The disclosed compositions contain calcium silicate in an amount ranging from about 0.1% to about 25% by weight (See Column 5, Line 66 to Column 6, Line 7).

Although the prior art does not explicitly disclose the limitations of Claim 5, it is the position of the examiner that as the prior art has disclosed the same calcium silicate material, the

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limitations of Claim 5 are met, since a composition of matter cannot stand apart from its properties. The instantly claimed invention is therefore anticipated.

Claims 1, 4, 5, 6, 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Withiam *et al.* (U.S. Patent Application Publication No. 2004/0001794, hereinafter Withiam II)

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The Withiam II reference teaches fluid cosmetic compositions comprising a calcium silicate (See Abstract). The calcium silicates preferably have an oil absorption of at least 200 mL/100g, with a particle size of less than 20 microns (See Section 0015). The compositions may be in the form of creams, lotions, gels, or a solid stick (See Sections 0027 and 0032). The disclosed compositions include a vehicle comprising various components such as astringents, emollients, emulsifiers, solvents, surfactants, waxes, wetting agents, and water (See Sections 0023 through 0032). The disclosed compositions contain calcium silicate in an amount ranging from about 0.5% to about 20% by weight (See Section 0022).

Although the prior art does not explicitly disclose the limitations of Claim 5, it is the position of the examiner that as the prior art has disclosed the same calcium silicate material, the

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limitations of Claim 5 are met, since a composition of matter cannot stand apart from its properties. The instantly claimed invention is therefore anticipated.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claims 1, 3-5 and 8-11 under 35 U.S.C. 103(a) Suffis *et al.* is hereby withdrawn.

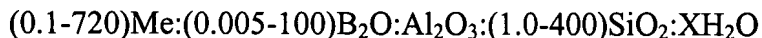
The rejection of Claim 6 under 35 U.S.C. 103(a) over Suffis *et al.* in view of Kuroda *et al.* is hereby withdrawn.

Claims 1, 3, 4, 5, 6, 8-11 rejected under 35 U.S.C. 103(a) as being unpatentable over Klein (U.S. Patent No. 4,388,301) in view of Withiam (U.S. Patent No. 4,557,916, hereinafter Withiam III).

The Klein patent teaches a deodorizing acne treatment composition, which in one embodiment comprises calcium silicate in an amount of 2.00% by weight. The disclosed composition further comprises fragrance and water as a carrier (See Example IV). The composition has an advantage of absorbing facial oils to assist in treating acne (See Column 5, Lines 15-27).

The Klein patent does not explicitly disclose the formula of the calcium silicate or its properties.

The Withiam III patent teaches a silicate material of the general formula:



where Me is an alkaline earth metal, B is an alkali metal, and X is an integer of 1 to 3 (See Abstract). In one embodiment, CaO is reacted with SiO<sub>2</sub> in a molar ratio that may range from 0.10:1 to 1.8:1 (See Claim 1). In one embodiment, a silica material is made where the average particle size is 7.5 microns, the oil absorption is 540 cc/100g and it has a 5% pH of 10.9. Such materials may be incorporated into pharmaceuticals and cosmetics as a carrier, absorbent, or filler (See Column 5, Lines 29-33).

It would be obvious to one of ordinary skill in the art to combine the prior art references to obtain the instantly claimed invention. One of ordinary skill, noting the high oil absorption rate of the metal silicates taught by Withiam III would seek to incorporate such materials into the invention of Klein to create a deodorizing acne treatment composition that has a greater effectiveness in absorbing facial oils, in keeping with the stated goal of that invention. As both prior art references are drawn to the use of silicates for their absorptive capacity in a cosmetic composition, they are analogous and one of ordinary skill in the art would therefore have a reasonable expectation of success in combining the references.

With regard to Claim 4, although the disclosed silicates in the Withiam III reference have an oil absorption of greater than the recited upper limit of 250 ml/100g, it is the position of the examiner that such a property can be readily manipulated by one of ordinary skill in the art, as the Withiam III reference makes clear that the oil absorption is directly dependent upon the source of reactive silica, and that silica of greater reactivity produces compositions having higher oil absorption (See Column 3, Lines 54-65). Thus to one of ordinary skill in the art, the oil absorption of a metal silicate may be adjusted by manipulating the reactivity of the silica used or

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by reducing its relative quantity on a molar basis to the other components of the disclosed silicate. Thus, the instantly claimed invention is obvious.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 4, 5, 6, 8-11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of U.S. Patent No. 7,163,669. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both drawn to the use of a fluid composition comprising a calcium silicate and a cosmetic ingredient.

Claims 1, 3, 4, 5, 6, 8-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 14-21 of copending Application No. 10/185,673. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because both sets of claims are drawn to a fluid personal care composition comprising a calcium silicate and a cosmetic ingredient. There exists an overlap in the ranges of oil absorption as well as the amount of calcium silicate present in the respective compositions. Both sets of claims also recite substantially similar cosmetic ingredients and vehicles, and formulated into substantially similar forms. Both sets of claims are also drawn to methods of inhibiting body odor by the use of the recited composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

Applicant's arguments filed 27 June 2006 have been fully considered and they have been found sufficiently persuasive to overcome the rejections of record. However, they are ultimately moot in view of the new grounds of rejection set forth above.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon J. Oh whose telephone number is (571) 272-0599. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Simon J. Oh  
Examiner  
Art Unit 1618

sj0

  
MICHAEL G. HARTLEY  
SUPERVISORY PATENT EXAMINER